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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,855	12/13/2001	Michel Bisson	BEAS-01052US1	3936
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FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			PHAM, HUNG Q	
			ART UNIT	PAPER NUMBER
			2168	

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/021,855	<b>Applicant(s)</b> BISSON ET AL.	
	<b>Examiner</b> HUNG Q. PHAM	<b>Art Unit</b> 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 24-39 and 63-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-39 and 63-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>110405</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to the rejection under 35 U.S.C. § 102 of claims 24-39 and 63-76 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

- The use of the trademark JAVABEANS and ENTERPRISE JAVABEANS has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

- Claims 27 and 71 are objected to because of the following informalities: *a personalization sever* ("a personalization sever" was specified in claims 24 and 68, "the personalization server" is suggested). Appropriate correction is required.

### ***Duplicate Claims, Warning***

Applicant is advised that should claims 1 and 68 be found allowable, claims 33 and 76 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that

they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 24, 25, 31, 33, 36, 63, 64, 66, 67, 68, 69, 75 and 76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 24, 25, 31, 33, 36, 63, 64, 66, 67, 68, 69, 75 and 76 contain the trademark/trade name JAVABEAN and ENTERPRISE JAVABEAN. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In

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the present case, the trademark/trade name is used to identify/describe computer program for developing and executing other computer programs on computers and, accordingly, the identification/description is indefinite.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 24, 33, 63, 68 and 76 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

As set forth in MPEP 2106 (IV)(B)(2)(b):

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan (discussed in i) below), or (B) be limited to a practical application within the technological arts (discussed in ii) below). See *Diamond v. Diehr*, 450 U.S. at 183-84, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1877)) (“A [statutory] process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.... The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence.”). See also *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *id.* at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) (“unpatentability of the principle does not defeat patentability of its practical applications”) (citing *O’Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). If a physical transformation occurs outside the computer, a disclosure that permits a skilled artisan to practice the claimed invention, i.e., to put it to a practical use, is sufficient. On the other hand, it is necessary for the claimed invention taken as a whole to produce a practical application if there is only a transformation of signals or data inside a computer or if a process merely manipulates concepts or converts one set of numbers into another.

A claimed process is clearly statutory if it results in a physical transformation outside the computer, i.e., falls into one or both of the following specific categories (“safe harbors”).

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## MPEP 2106(IV)(B)(2)(b)(ii)

For such subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *Alappat* 33 F.3d at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) ("unpatentability of the principle does not defeat patentability of its practical applications") (citing *O'Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See *AT & T*, 172 F.3d at 1358, 50 USPQ2d at 1452. Likewise, a machine claim is statutory when the machine, as claimed, produces a concrete, tangible and useful result (as in *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601) and/or when a specific machine is being claimed (as in *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557 (\**en banc*)). For example, a computer process that simply calculates a mathematical algorithm that models noise is nonstatutory. However, a claimed process for digitally filtering noise employing the mathematical algorithm is statutory.

- MPEP 2106(IV)(B)(2)(a):

A *machine* is "a concrete thing, consisting of parts or of certain devices and combinations of devices." *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863).

If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760. Office personnel must treat each claim as a whole. The mere fact that a hardware element is recited in a claim does not necessarily limit the claim to a specific machine or manufacture. Cf. *In re Iwahashi*, 888 F.2d 1370, 1374-75, 12 USPQ2d 1908, 1911-12 (Fed. Cir. 1989), cited with approval in *Alappat*, 33 F.3d at 1544 n.24, 31 USPQ2d at 1558 n.24.

Claims 24 and 33 are process claims. Claim 63 is directed to a computer program executing a process. The process as in claims 24 and 33, and computer program executing a process as in claim 63 do not produce a tangible result as set forth in MPEP. Therefore, claims 24, 33 and 63 are non-statutory.

Regarding the system claims 68 and 76, there is no *physical structure of the machine or manufacture in terms of its hardware or hardware and software combination*. The *base user java bean*, *enterprise java bean*, and *means for extending the user java bean* as recited in the claims are software *per se*. Therefore, claims 68 and 76 are non-statutory.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 24-39 and 63-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singer et al. [USP 6,557,009 B1] in view of Timbol [USP 6,237,135 B1].**

Regarding claims 24, 33, 63, 68 and 76, Singer teaches *a method, program and system for generating a unified user profile for providing transparent access to a personalization database and external user database* (As in FIG. 3Ci, *a unified user profile* is created for providing transparent access to a

*personalization database*, e.g., permit database 18 of FIG. 1, and *external user database*, e.g., the database as illustrated at Col. 8, Lines 30-41 controlled by e-payment system 20 of FIG. 1).

The Singer method comprises the step of:

*accessing said personalization database through a personalization server, retrieving and updating implicit and explicit properties from the personalization database* (FIG. 1, Application Server 16 as a personalization server, Permit Database 18 as *personalization database*, or *internal data source*, or *first database*. FIG.

3Civ, *implicit properties*, e.g., a property without an asterisk, and *explicit properties*, e.g., a property with an asterisk, are retrieved and updated as disclosed at Col. 6, Lines 55-57); and

*transparently retrieving and updating said implicit and explicit properties from an external user database* (FIG. 3G, *implicit properties*, e.g., a property without an asterisk, and *explicit properties*, e.g., a property with an asterisk, are retrieved and updated from *external user database*, or *external data source*, or *second database*, e.g., the database as illustrated at Col. 8, Lines 30-41 controlled by e-payment system 20 of FIG. 1, as disclosed at Col. 8, Lines 37-43).

The missing of Singer method is the step of *obtaining a base user java bean and creating an enterprise java bean to extend the base user java bean* adapted<sup>1</sup> to perform the process.

As further suggested by Singer, Enterprise Java Beans is preferably used to implement the steps as discussed above (Singer, Col. 5, Line 66-Col. 6, Line 4).

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<sup>1</sup> As set forth in MPEP 2111.04:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Id.*<

Examiner respectfully suggests applicants replacing the "adapted to" and "such that" clause by a positive statement that discloses the claimed invention.



Timbol discloses a method of *obtaining a base user java bean* and *creating an enterprise java bean to extend the base user java bean* via a user interface at FIG. 3 and 11. The JAVABEANS and ETERPISE JAVABEANS as taught by Timbol are adapted to implement the Singer process (Col. 10, Line 43-Col. 14, Line 3 and Col. 19, Line 14-Col. 21, Line 6).

It would have been obvious for one of ordinary skill in the art at the time the invention was made to use JAVABEANS and ETERPISE JAVABEANS as taught by Timbol to implement the Singer method as suggested in order to create Web Application as disclosed by Singer as in FIG. 3.

Regarding claims 25, 64 and 69, Singer and Timbol, in combination, teach all of the claimed subject matter as discussed above with respect to claims 24, 63 and 68, Singer further discloses the step of *generating transparent read and write access to said external database* (Singer, Col. 8, Lines 37-62). Timbol teaches ETERPISE JAVABEANS as *extended said base user java bean* as discussed above with respect to claim 24. It would have been obvious for one of ordinary skill in the art at the time the invention was made to combine the method of creating JAVABEANS and ETERPISE JAVABEANS as taught by Timbol into Singer method as suggested in order to create Web Application as disclosed by Singer as in FIG. 3G.

Regarding claims 26, 34 and 70, Singer and Timbol, in combination, teach all of the claimed subject matter as discussed above with respect to claims 24, 33 and 68,

Singer further discloses the step of *configuring a server to provide said read and write access* (Singer, Col. 6, Lines 18-25).

Regarding claims 27 and 71, Singer and Timbol, in combination, teach all of the claimed subject matter as discussed above with respect to claims 26 and 68, Singer further discloses *server is a personalization server* (Singer, FIG. 1, Col. 6, Lines 18-25).

Regarding claims 28 and 72, Singer and Timbol, in combination, teach all of the claimed subject matter as discussed above with respect to claims 24 and 68, Singer further discloses *external user database is selected from the group consisting of legacy databases, corporate databases, and customer databases* (Singer, Col. 8, Lines 33-62).

Regarding claims 29 and 73, Singer and Timbol, in combination, teach all of the claimed subject matter as discussed above with respect to claims 24 and 68, Singer further discloses *external user database contains data selected from the group consisting of authentication information, user lists, group lists, and group membership* (Singer, Col. 8, Lines 33-62).

Regarding claims 30, 35, 65 and 74, Singer and Timbol, in combination, teach all of the claimed subject matter as discussed above with respect to claims 24, 33, 63 and 68, Singer further discloses the step of *obtaining a security realm adapted to<sup>2</sup> allow authentication of data in said personalization database and said external user database* (Singer, Col. 6, Lines 26-53).

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<sup>2</sup> See Footnote 1.

Regarding claims 31, 66 and 75, Singer and Timbol, in combination, teach all of the claimed subject matter as discussed above with respect to claims 24, 63 and 68, Timbol further discloses *the extended base user java bean utilizes a property set, said property set adapted to<sup>3</sup> give namespace qualifications to implicit and explicit properties of said data in said personalization database* (Timbol, Col. 11, Line 54-Col. 12, Line 55 and FIG. 3Civ of Singer reference).

Regarding claims 32 and 38, Singer and Timbol, in combination, teach all of the claimed subject matter as discussed above with respect to claims 31 and 37, Timbol further discloses *implicit and explicit properties comprise getter and setter properties* (Timbol, Col. 11, Lines 46-53 and Col. 12, Lines 20-40).

Regarding claim 36, Singer and Timbol, in combination, teach all of the claimed subject matter as discussed above with respect to claim 33, Timbol further discloses the step of *configuring a property set for the extended user java bean* (Timbol, Col. 11, Line 54-Col. 12, Line 55).

Regarding claim 37, Singer and Timbol, in combination, teach all of the claimed subject matter as discussed above with respect to claim 36, Timbol further discloses *property set is adapted to give namespace qualifications to implicit and explicit properties of said data in said internal and external data sources* (Timbol, Col. 11, Line 54-Col. 12, Line 55 and FIG. 3Civ of Singer reference).

Regarding claim 39, Singer and Timbol, in combination, teach all of the claimed subject matter as discussed above with respect to claim 37, Timbol further discloses the step of *using reflection to determine whether a property of said data in said internal and external data sources is explicit* (Timbol, Col. 12, Line 56-Col. 13, Line 3).

Regarding claim 67, Singer and Timbol, in combination, teach all of the claimed subject matter as discussed above with respect to claim 63, Timbol further discloses *the extended base user java bean utilizes getter and setter properties* (Timbol, Col. 11, Lines 46-53 and Col. 12, Lines 20-40).

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<sup>3</sup> See Footnote 1.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY A. GAFFIN can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
HUNG Q PHAM  
Examiner  
Art Unit 2168

February 1, 2006